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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,279	02/26/2004	Patrick R. Connelly	034405-014	5157

  

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EXAMINER	
JUNG, UNSU	

  

ART UNIT	PAPER NUMBER
1641	

  

NOTIFICATION DATE	DELIVERY MODE
12/14/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/787,279	<b>Applicant(s)</b> CONNELLY ET AL.	
	<b>Examiner</b> Unsu Jung	<b>Art Unit</b> 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 55-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 55-70 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group II (claim 55) in the reply filed on September 27, 2007 is acknowledged. The reply further included cancellation of non-elected claims 38-54 and addition of new claims 56-70.
2. Claims 55-70 are pending.

### *Election of Species*

3. This application contains claims directed to the following patentably distinct species of the claimed invention. The applicant is required to elect one species from each of the following six lists of species:

#### List I: Assembly (claims 56, 57, 61, and 62)

- A. Assembly implanted in a body (claim 56)
- B. Assembly is present outside of a body (claim 57)
- C. Stent (claim 61)
- D. Catheter (claim 61)
- E. Cannula (claim 61)
- F. Capsule (claim 61)
- G. Patch (claim 61)
- H. Wire (claim 61)
- I. Infusion sleeve (claim 61)
- J. Fiber (claim 61)
- K. Shunt (claim 61)
- L. Graft (claim 61)
- M. Polymer (claim 62)
- N. Fiber (claim 62)
- O. Diatomaceous earth (claim 62)
- P. Glass (claim 62)
- Q. Metal (claim 62)

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- R. Colloid (claim 62)
- S. Plastic (claim 62)

List II: Fluid (claims 58)

- A. Blood (claim 58)
- B. Bone marrow (claim 58)
- C. Lymph (claim 58)
- D. Urine (claim 58)
- E. Bile (claim 58)
- F. Cerebral spinal fluid (claim 58)
- G. A combination thereof (for this species, Applicant is further required to select a specific combination of fluids selected from this list) (claim 58)

List III: Biological Target (claim 60)

- A. Metastatic cancer cell (claim 60)
- B. Stem cell (claim 60)
- C. Immunological cell (claim 60)

List IV: Target-Specific Binding Agent (claim 63)

- A. E-selectin (claim 63)
- B. P-selectin (claim 63)
- C. ICAM-1 (claim 63)
- D. Cadherin-11 (claim 63)
- H. A combination thereof (for this species, Applicant is further required to select a specific combination of target-specific binding agents selected from this list) (claim 63)

List V: Target-Specific Binding Agent on the Capture Zone Surface (claim 68)

- A. Absorbed (claim 68)
- B. Covalently bonded (claim 68)

List VI: Additional Components of Capture Zone (claims 69 and 70)

- A. Anti-proliferative agent (claims 69 and 70)
  - i. Adsorbed
  - ii. Covalently bonded
- B. Toxic agent (claims 69 and 70)
  - i. Adsorbed
  - ii. Covalently bonded
- C. Bio-active agent (claims 69 and 70)
  - i. Adsorbed
  - ii. Covalently bonded

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- D. A combination thereof, for neutralizing the biological target (for this species, Applicant is further required to select a specific combination of agents selected from this list) (claims 69 and 70)
  - i. Adsorbed
  - ii. Covalently bonded

Applicant is further reminded that the species selected from Lists III and IV must be consistent.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 55, 59, and 64-67 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the

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election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Unsu Jung whose telephone number is 571-272-8506. The examiner can normally be reached on M-F: 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Unsu Jung/  
Unsu Jung, Ph.D.  
Patent Examiner  
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